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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,586	08/29/2003	Dennis York	TRMB1412	9289

7590 11/01/2007

WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
San Jose, CA 95113

EXAMINER	
PEYTON, TAMMARA R	

ART UNIT	PAPER NUMBER
2182	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/651,586
Filing Date: August 29, 2003
Appellant(s): YORK, DENNIS

John P. Wagner, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07/30/07 appealing from the Office action mailed 01/24/07.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of the amendment after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-30 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Number	Name	Date
US 6,798,647	Dickie	Issued 09/28/2004
US 6,538,880	Kamijo et al.	Issued 03/25/2003
US 5,859,628	Ross	Issued 01/12/1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickie (US 6,798,647).

A) As per claim 1, Dickie teaches a processing unit (PDA, 102) for an electronic instrument comprising:

a signal/data processor (figure 4, element 400);

an exposed external electrical contact (304) for receiving electric power input (using interface 404 to 414 via communication channel 420);

an exposed external electrical contact (304) for receiving an electric signal input (using interface 404 to 414 via communication channel 420);

an exposed external electrical contact for (304) transmitting an electrical signal output (using interface 404 to 414 via communication channel 420); and

a housing (102) comprising mechanical retention features for securely attaching a battery/input/output module. (see figure 4, housing of PDA 102 securely attaches to battery/input/output module 104, col. 3, lines 62-col. 4, lines 1-47)

B) As per claims 2-4, 6, and 7, Dickie teaches wherein said processing unit comprises a memory (402), keypad (206), microprocessor (400), and touch panel display (Fig. 4, 204).

C) As per claim 5, Dickie teaches wherein the contacts may be sealed through the attachment of a cover to the surface of said housing.

D) As per claim 8, Dickie teaches a portable battery/input/output module (portable computer, 104) for a portable electronic instrument comprising:

a storage device (Fig. 4) for electric energy;

an exposed external electrical contact (310, Fig. 3) for transmitting electric

power; (using interface 414 to 404 via communication channel 420);

an exposed external electrical contact (310, Fig. 3) for receiving an electric signal input; (using interface 414 to 404 via communication channel 420);

an exposed external electrical contact (310, Fig.3) for transmitting an electrical signal output; (using interface 414 to 404 via communication channel 420);

a housing (120, Fig.1) comprising mechanical retention features for securely attaching a processing unit.(cols. 2-5)

E) As per claim 9, Dickie teaches wherein the contacts may be sealed through the attachment of a cover to the surface of said housing. (col. 3, lines 62-col. 4, lines 1-47)

F) As per claims 10-12, Dickie teaches wherein communication between the battery/input/output module (portable computer, 104) and said exposed electrical contact may be either direct electrical coupling or proximity/IR/RF coupling (col. 3, lines 14-18). Dickie does not expressly teaches wherein the direct electrical coupling could be a serial or parallel communication port, however, one of ordinary skill would readily recognize that applying a known or common communication port would have been obvious and recognized as part of the ordinary capabilities of one skilled in the art as a known or common communication method.

G) As per claim 13 and 14 Dickie obviously teaches further comprising an embedded inductive charger for said energy storage device (col. 4 lines 4-11).

H) As per claim 15-19, Dickie teaches a processing unit coupled to a battery/input/output module, please see rejection for claims 1 and 8 above.

2. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dickie (US 6,798,647) and Kamijo et al., (US 6,538,880) or Ross (5,859,628), previously sited.

A) As per claim 20, Dickie does not expressly teach of said portable electronic instrument comprises a GPS, however, Kamijo teaches a portable electronic instrument that exchanges data and has the ability to charge the battery of the instrument wherein the instrument comprises GPS. It would have been obvious to one of ordinary skill at the time the invention was made that Dickie would have been motivated to implement other types of application program includes a GPS application program as taught by Kamijo because doing so would add and expand the flexibility of Dickie's portable electronic instrument by displaying to a user a plurality of location maps. (Kamijo, col. 5, lines 10-16) Further, Ross teaches a portable electronic instrument that comprises a GPS and it would have been obvious to one of ordinary skill that Dickie would have been motivated to implement other types of application program includes a GPS application program as taught by Ross because doing so would add and expand the

flexibility of Dickie's portable electronic instrument by relaying to a user a plurality of locations. (Ross, col. 8, lines 20-25)

(11) Response to Argument

Dickie teaches "a signal/data processor, an exposed external electrical contact (304) for receiving electric power input (using interface 404 to 414 via communication channel 420); an exposed external electrical contact (304) for receiving an electric signal input (using interface 404 to 414 via communication channel 420); an exposed external electrical contact for (304) transmitting an electrical signal output (using interface 404 to 414 via communication channel 420); and a housing (102) comprising mechanical retention features for securely attaching a battery/input/output module. (see figure 4, housing of PDA 102 securely attaches to battery/input/output module 104, col. 3, lines 62-col. 4, lines 1-47) of claims 1 and 15.

A) Appellant argues that:

> **(1) "a housing comprising mechanical retention features for securely attaching a battery/input/output module" (emphasis added). Thus, it is the housing that retains the battery/input/output module in Claims 1 and 15.**
>
> **(2) In contrast, Appellant respectfully states that Dickie teaches that it is the portable computer 104 that physically stores and protects the PDA 102 when docked (emphasis added). For this reason, Appellant respectfully states that Dickie does not teach or render obvious the features of Claims 1 and 15. As such, the**

rejection under 35 U.S.C. §1030) is improper as an essential element needed for a proper prima facie rejections is missing"(See Appeal Brief, pg. 12, paragraphs 1-3)

In response, Appellant is reminded that claims subject to examination will be given their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023,1027-28 (Fed. Cir. 1997).

With this in mind, the discussion will focus on how the terms and relationships between the terms in the claims are met by the references.

(1) Appellant argues "**it is the housing that retains the battery/input/output module in Claims 1 and 15.**" Examiner is taking the position that the **"housing"** referred to in claim 1 and 15 is the housing of the PDA that has the mechanical retention features and Examiner is taking the position wherein the portable computer 104 is a "**battery/input/output module**" to the PDA 102. The PDA 102 has a housing that has "mechanical retention features" of a first end 304 and the second end 308 of PDA 102 for securely attaching the "**battery/input/output module**" via the mechanical retention features (See 210, 300, 306, 310, and 302, col. 3, lines 28-61) of the portable computer 104 (Dickie, col. 3, lines 62-col. 4, lines 1-47). Further, one of ordinary skill would readily recognize that the PDA's overall housing would be tailored to specific dimensions – therein the PDA must have mechanical retention features" in order for Dickie's PDA to securely fit and be retained in a housing of the portable computer.

(2) Appellant argues that "**In contrast, Appellant respectfully states that Dickie teaches that it is the portable computer 104 that physically stores and**

protects the PDA 102 when docked (emphasis added)." Examiner does not disagree with Appellant's interpretation of the portable computer "docking" the PDA, nonetheless, Examiner is taking the position that Dickie's "docking" of the PDA is equivalent to the PDA having a **housing comprising mechanical retention features** for **securely attaching** [to] a the portable computer, i.e. **battery/input/output module.**"

B) Appellant argues that this is not equivalent because:

> **(3) Thus, Appellant respectfully submits that PDA 102 of Dickie is already taught as having its own battery and that the portable computer 104 of Dickie is not a battery/input/output module as stated by the Examiner but is instead a dock as taught by Dickie. Thus, Appellant respectfully submits that PDA 102 of Dickie is already taught as having its own battery and that the portable computer 104 of Dickie is not a battery/input/output module as stated by the Examiner but is instead a dock as taught by Dickie"** "(See Appeal Brief, pg. 12- paragraph 1 of pg. 13)

In response, Examiner does not understand Appellant's argument regarding the Dickie's PDA already taught having its own battery. No wherein in claims 1 and 15 does it convey that the processing unit (PDA) lacks an internal battery, therein, Appellant's arguments imply that the portable device does not need an internal battery and further Appellant is arguing issues that are not in the claim. Examiner does not understand how the battery/input/output module would charge the portable device of Appellant if the portable device of Appellant does not already include a type of internal battery. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057*

(Fed. Cir. 1993). If it was Applicant's intention that the claim be limited to a processing unit that does not have its own battery, then Appellant should have fashioned the claim in a precise, clear, and unambiguous matter in order to overcome the Dickie reference.

Further, subject matter contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).* Furthermore, Examiner is taking the position that the portable computer 104 of Dickie acts as a "battery/input/output module" by charging the internal battery of PDA, 102.

C) Appellant argues that:

> **" (4) In addition, Appellant respectfully submits that page 11 of the specification clearly defines the battery/input/output module including in the description of Figures 2 and 3 wherein the battery/input/output module is described as "The battery/input/output module 110 houses a rechargeable energy storage device that is coupled to at least one of the contacts 125. The rechargeable energy storage device may be a battery or a capacitor. The energy storage device may be recharged by connecting an external power source to the power port 255. Alternatively, the energy storage device may be charged by inductively coupling to a recharging circuit sealed within the module 110.... The module 110 may also be shaped to wrap around the processing unit 105 to provide shock resistance for the processing unit 105." (emphasis added)....Therefore, Appellant respectfully submits that the portable computer of Dickie (including a processor 410, one or more storages 412 (e.g., RAM, ROM, hard disk, fl0ppy disk, CD-ROM, DVD, etc.), an interface 414, the display 110, the keyboard 114, the mouse pad 116, and the status LCD 124) is clearly not a battery/input/output module as defined in the present**

Specification "(See Appeal Brief, pg. 13, third paragraph – pg. 14, second paragraph and pg.16)

In response, note that Appellant is arguing limitations of the specification to define the "battery/input/output module." Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).* Further, disclose contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).*

Nonetheless, Examiner is taking the position wherein the portable computer 104 meets the requirements for a "battery/input/output module" as defined by Appellant. Specifically, the portable computer 104 would obviously have a rechargeable energy storage device because it would have been common knowledge as part of the ordinary capabilities of one skilled in the art to be aware that a portable computer would have a rechargeable energy storage device i.e. an internal battery that could be recharged by connecting portable computer to an external power source via a power cord.

D) Appellant argues that:

(5) For at least the same reasons provided above, e.g., the portable computer 104 physically stores and protects the PDA 102 when docked and that PDA 102 of Dickie is already taught as having its own battery and that the portable computer 104 of Dickie is not a battery/input/output module as stated by the Examiner but is instead a dock as taught by Dickie (emphasis added). Appellant respectfully submits that Dickie does not teach or render obvious the features of" A portable battery/input/output module for a portable electronic instrument comprising: a storage device for electric energy; an exposed external electrical contact for transmitting electric power; an exposed external electrical contact for receiving an

> **electric signal input; an exposed external electrical contact for transmitting an electrical signal output; a housing comprising mechanical retention features for securely attaching a processing unit as provided in Claim 8. As such, the rejection under 35 U.S.C. § 103(a) is improper as an essential element needed for a proper prima facie rejections is missing.** (See Appeal Brief, pg. 13, second paragraph)

In response, Appellant argues that Dickie does not teach "**a housing comprising mechanical retention features for securely attaching a processing unit as provided in Claim 8.**" Dickie teaches a portable battery/input/output module (portable computer, 104) for a portable electronic instrument comprising: a storage device (Fig. 4) for electric energy; an exposed external electrical contact (310, Fig. 3) for transmitting electric power; (using interface 414 to 404 via communication channel 420); an exposed external electrical contact (310, Fig. 3) for receiving an electric signal input; (using interface 414 to 404 via communication channel 420); an exposed external electrical contact (310, Fig.3) for transmitting an electrical signal output; (using interface 414 to 404 via communication channel 420); a housing (120, Fig.1) comprising mechanical retention features for securely attaching a processing unit.(cols. 2-5).

Examiner is taking the position that the **"housing"** referred to in claim 8 is the housing of the portable computer. Examiner is taking the position wherein the portable computer 104 is a "**battery/input/output module"** to the PDA 102 and that the portable computer 104 is a housing that has "mechanical retention features" (See 210, 300, 306, 310, and 302, col. 3, lines 28-61) for securely attaching to the PDA via a first end 304 and the second end 308 of PDA 102. Further, Examiner would like Appellant to note some of the key "mechanical retention features" of portable computer 104: a movable

platform 300, springs 302, housing lip, 306, electrical contact, 306, and for securely attaching the PDA is a release latch, 210. One of ordinary skill would readily recognize that the housing of portable computer 104 has mechanical retention features" in order for the portable computer to retain the housing of the PDA.

E) Appellant argues that:

> **Regarding Claims 10-12, Appellant did not find any reasons cited by the Examiner for the rejection of Claims 10-12. For this reason, Appellant submits that the undisclosed rejection of Claims 10-12 is improper and that Claims 10-12 are allowable.** (See Appeal Brief, pg. 15)

Due to an oversight by Examiner specific references to the rejection of claims 10-12 where not expressly detailed. However, Examiner did in fact reject these claims as claims 1-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dickie (US 6,798,647). Claims 10-12 are taught by Dickie wherein communication between the battery/input/output module (portable computer, 104) and said exposed electrical contact may be either direct electrical coupling or proximity/IR/RF coupling (col. 3, lines 14-18). Dickie does not expressly teach the direct electrical coupling is a serial or parallel communication port, however, one of ordinary skill would readily recognize that applying a known or common communication port would have been obvious and recognized as part of the ordinary capabilities of one skilled in the art as a known or common communication method.

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

TAMMARA PEYTON
PRIMARY EXAMINER

Tammara Peyton
Primary Examiner
Technology Center 2100

Conferees:

/Lynne H Browne/
Lynne H Browne
Appeal Practice Specialist, TQAS
Technology Center 2100

KIM HUYNH
SUPERVISORY PATENT EXAMINER

Kim Huynh
Supervisor 2182
Technology Center 2100